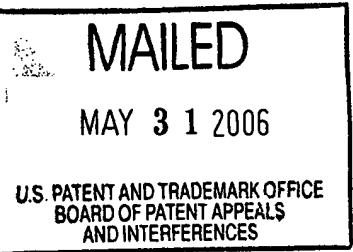


The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DELPHINE COPPENS
and PIERRE CONGARD



Appeal No. 2006-0468
Application 09/885,395

ON BRIEF

Before WARREN, WALTZ and FRANKLIN, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 19 through 30, all of the claims in the application.

Claims 19 and 26 illustrate appellants' invention of a label, and is representative of the claims on appeal:

19. A label, comprising in the order given:

a backing layer;

a first adhesive layer comprising a heat activatable adhesive; and

a second adhesive layer other than a hot melt adhesive layer, comprising an elastomeric microsphere adhesive.

26. A label comprising:

a backing layer having first and second major side;

a first adhesive layer comprising a heat activatable adhesive and carried by the first major side of the backing layer;

a second adhesive layer other than a hot melt adhesive layer, comprising an elastomeric microsphere adhesive and carried by the first adhesive layer; and

means for retroreflecting light carried by the second major side of the backing layer.

The references relied on by the examiner are:

Bingham	3,758,192	Sep. 11, 1973
Silver et al. (Silver)	5,118,750	Jun. 2, 1992
Stahl	6,194,044	Feb. 27, 2001

The examiner has rejected appealed claims 19, 20, 22, 24 and 25 under 35 U.S.C.

§ 103(a) as being unpatentable over Stahl in view of Silver (final action mailed November 1, 2004 (final action), pages 2-4), and appealed claims 21, 23 and 26 through 30 under 35 U.S.C.

§ 103(a) as being unpatentable over Stahl in view of Silver, and further in view of Bingham (final action, pages 4-5).¹

Appellants argue claims of each ground of rejection as a group (see brief in entirety). Thus, we decide this appeal based on independent claims 19 and 26 as representative of the grounds of rejection and appellants' groupings of claims. 37 CFR § 41.37(c)(1)(vii) (September 2004).

We affirm.

Rather than reiterate the respective positions advanced by the examiner and appellants, we refer to the answer and to the brief for a complete exposition thereof.

Opinion

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the supported position advanced by the examiner that, *prima facie*, the claimed labels encompassed by claims 19 and 26 would have been obvious over the combined teachings of Stahl and Silver with respect to claim 19 and the combined teachings of Stahl, Silver and Bingham with respect to claim 26 to one of ordinary skill in this art at the time the claimed invention was made. Accordingly, since a *prima facie* case of obviousness has been established

¹ The examiner states the grounds of rejection in the answer but does not specify the Office action in which the complete statement of the grounds of rejection can be found (page 3). We find the complete statements in the final action.

by the examiner, we again evaluate all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellants' arguments in the brief and the evidence in the specification to the extent relied on in the brief. *See generally, In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

We find ourselves in agreement with the examiner's findings of fact from the references and conclusions of law based thereon as set forth in the final action with respect to each ground of rejection to which we add the following for emphasis.

The plain language of claim 19 specifies any manner of label comprising at least, "in the order given," a first adhesive layer comprising at least any amount, however small, of any manner of heat activatable adhesive, and a second adhesive layer comprising at least any amount, however small, of any manner of elastomeric microsphere adhesive, wherein the second adhesive layer is "other than" any manner of "a hot melt adhesive layer." The open-ended term "comprising" used in transition and in the body of the claim opens the claim to include labels containing any manner of other layers and additional ingredients in the layers, such as for example, all of the labels that fall within claim 26. *See generally, Exxon Chem. Pats., Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1555, 35 USPQ2d 1801, 1802 (Fed. Cir. 1995) ("The claimed composition is defined as comprising - meaning containing at least - five specific ingredients."); *In re Baxter*, 656 F.2d 679, 686-87, 210 USPQ 795, 802-03 (CCPA 1981) ("As long as one of the monomers in the reaction is propylene, any other monomer may be present, because the term 'comprises' permits the *inclusion* of other steps, elements, or materials."). Indeed, appellants specifically state in the written description that "[t]he term 'in the order given' . . . does not exclude . . . other layers" and disclose other ingredients which can be present (e.g., page 3, ll. 17-19, and page 5, ll. 9-16). The term "heat activatable adhesive" is not defined in the written description in the specification, it being disclosed that the term encompasses "generally an adhesive that is non-tacky at room temperature," and is not made definite by the definition of "permanently bonded" (page 4, ll. 20-21). The term "hot melt adhesive" is not defined at all. We agree with the examiner that the term has its common, art accepted, dictionary meaning

(answer, page 5),² and as such, is recognized by one of ordinary skill in the art as a specific type of heat activatable adhesive. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004); *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The plain language of claim 26 includes the terms and phrases we consider above. This claim additionally specifies “means for retroreflecting light.” The examiner and appellants do not provide an interpretation for this language which specifies a function without defining structure which satisfies that function and thus, the strictures of 35 U. S. C. § 112, sixth paragraph, apply. *See Texas Digital Systems, Inc. v. Telegenx, Inc.*, 308 F.3d 1193, 1208, 64 USPQ2d 1812, 1822-23 (Fed. Cir 2002), and cases cited therein. We find ample disclosure of “corresponding structure” for such “means” in the written description in the specification, in fact encompassing the retroreflecting structure in Bingham, and thus a determination of whether the Bingham structure is a § 112, sixth paragraph, “equivalent” is not necessary to our decision. *See Texas Digital Systems*, 308 F.3d at 1208, 64 USPQ2d at 1822-23; *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315-16 (Fed. Cir. 2000); *In re Donaldson Co.*, 16 F.3d 1189, 1192-95, 29 USPQ2d 1845, 1848-50 (Fed. Cir. 1994) (*en banc*). Indeed, appellants do not dispute the examiner’s application of Bingham on this basis.

Appellants submit that Stahl teaches a preference for the second adhesive layer comprising a “heat sensitive adhesive” at col. 4, ll. 60-61, and col. 5, ll. 13-14, while Silver discloses a “non-heat sensitive” elastomeric microsphere adhesive, and thus, argue that there is no motivation to combine the references (brief, page 5; original emphasis deleted). Appellants further submit that Stahl does not state whether pressure-sensitive adhesive layer 16 which coats thermoplastic layer 14, is a hot melt adhesive, citing, e.g., col. 3, ll. 1-3, contending that the examiner has not established that the adhesive layer 16 is not a hot melt adhesive, and pointing to their previous argument that Stahl discloses a heat sensitive adhesive which “leads away from the claimed invention” which requires that the second adhesive layer is other than a hot melt

² *See also “adhesive, hot-melt,” Hawley’s Condensed Chemical Dictionary* 23 (13th ed., Richard J. Lewis, Sr., revisor, New York, Van Nostrand Reinhold Company, 1997).

adhesive layer (brief, pages 6-7). With respect to the second ground of rejection, appellants submit “that Bingham fails to provide the motivation to combine documents that is missing from Stahl in view of [Silver], as noted herein above” (*id.*, pages 8-9).

The examiner responds that one of ordinary skill in this art would have modified the pressure-sensitive adhesive layer **16** of Stahl with the elastomeric microsphere adhesives of Silver in order to minimize loss of the layer by transfer upon repositioning of the label on a substrate (answer, pages 4 and 6-7; final action, pages 3-4). The examiner further points out that there is no teaching in Stahl that the heat sensitive pressure sensitive adhesive is a “hot melt adhesive” as this term is used in the art (answer, pages 5 and 6).

We find substantial evidence in the combined teachings of Stahl and Silver supporting the examiner’s position. We find that contrary to appellants’ contention, Stahl would have disclosed to one of ordinary skill in this art that the pressure-sensitive adhesive layer **16** “is preferably an acrylic ester polymer or copolymer,” among others, which permits repositioning of the label (e.g., col. 3, ll. 16-18). We further find that Silver would have disclosed to this person a pressure sensitive adhesive containing elastomeric polyacrylate ester microspheres which can be applied to, among others, plastic substrates by spraying or in sheet form, and permits the substrate to be repositioned with low transfer to the substrate (e.g., col. 1, ll. 9-14, col. 3, ll. 12-45, and col. 8, ll. 61-65). Indeed, one of ordinary skill in this art routinely following the combined teachings of Stahl and Silver and further with Bingham, would have been led to use the elastomeric polyacrylate ester microsphere containing pressure sensitive adhesive of Silver as a preferred polyacrylate ester pressure sensitive adhesive for pressure-sensitive adhesive layer **16** of Stahl in the reasonable expectation of repositionally applying the label containing such layer in the manner taught by Stahl. Thus, one of ordinary skill in the art would have reasonably arrived at the claimed invention encompassed by appealed claims 19 and 26 as we have interpreted these claims above, including every limitation thereof arranged as required therein, without recourse to appellants’ specification. *See In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988) (“The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that [the claimed process] should be carried out and would have a reasonable likelihood of success viewed in light of the prior art.

[Citations omitted] Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure."); *In re Keller*, 642 F.2d 413, 425-26, 208 USPQ 871, 881-82 (CCPA 1981) ("The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.").

We now turn to the evidence of nonobviousness based on a comparison involving Comparative Example C2 and inventive Example 4 as shown in specification Table 1 on which appellants rely in the brief (pages 5-6). We initially point out to the examiner that there is no requirement that a property disclosed in the specification for a product must be specified in a claim encompassing that product in order for appellants to rely on that property with respect to unexpected results. However, appellants have the burden to submit an explanation or evidence with respect to the practical significance of the results of the submitted comparison vis-à-vis the teachings of the applied references and why the results would have been considered unexpected. *See generally, In re Geisler*, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997); *In re Merck*, 800 F.2d 1091, 1099, 231 USPQ 375, 381 (Fed. Cir. 1986); *In re Longi*, 759 F.2d 887, 897, 225 USPQ 645, 651-52 (Fed. Cir. 1985); *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *In re Klosak*, 455 F.2d 1077, 1080, 173 USPQ 14, 16 (CCPA 1972); *In re D'Ancicco*, 439 F.2d 1244, 1248, 169 USPQ 303, 306 (1971). We find that appellants have not carried their burden.

Appellants disclose in the specification that the label of Comparative Example 2 is a "reflective material bearing the heat-activated adhesive, as described in Example 1, [that] was coated with two thicknesses, respectively, of a solvent-borne acrylic pressure-sensitive adhesive (available as AEROSET™ 1450-Z-4)" in which the substrate is "[a] retroreflective material bearing a heat-activatable adhesive (commercially available as 3M™ SCOTCHLITE™ Reflective Material . . .)" and the "PSA dry thickness, μm " of each thickness is "20" (page 12, l. 30, to page 13, l. 2, page 14, ll. 8-10, and specification Table 1). Inventive Example 4 is described as "[a] microsphere pressure-sensitive adhesive dispersed in a solvent as described in

US 3,691,140 . . . and US 4,166,152 . . . was coated on the heat-activated adhesive-bearing surface" of the same 3M™ SCOTCHLITE™ Reflective Material, apparently in a single thickness at a "PSA dry thickness, μm " of "20" (page 13, l. 30, to page 14, l. 1, and specification Table 1).

In the absence of an explanation or evidence with respect to the practical significance of the results of this comparison vis-à-vis the combined teachings of Stahl and Silver and why the results would have been considered unexpected, we find that the results shown in specification for Comparative Example 2 and inventive Example 4 are no more than those expected between labels which have two 20 μm layers of a polyacrylic PSA and one 20 μm layer of an elastomeric polyacrylate ester microsphere PSA by one of ordinary skill in the art. Indeed, this person would have expected differences in the demonstrated properties with substrates differing in the number of layers of PSA and in the type of PSA, and particularly since elastomeric polyacrylate ester microsphere PSAs were acknowledged by Silver to be known in the art to provide repositioning even if the same have deficiencies on which the elastomeric polyacrylate ester microsphere PSAs of Silver were disclosed to be an improvement (e.g., col. 1, ll. 29-44, and col. 3, ll. 12-23). Thus, on this record, we find that the evidence in the specification does not reflect the applied prior art and the unexplained use of two layers of PSA in preparing Comparative Example 2 inserts an unfixed variable. *See generally, In re Baxter Travenol Labs.*, 952 F.2d 388, 392, 21 USPQ2d 1281, 1285 (Fed. Cir. 1991) ("[W]hen unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared to the closest prior art. [Citation omitted.]"); *In re Burckel*, 592 F.2d 1175, 1179-80, 201 USPQ 67, 71 (CCPA 1979) (the claimed subject matter must be compared with the closest prior art in a manner which addresses the thrust of the rejection); *In re Hoffmann*, 556 F.2d 539, 541, 194 USPQ 126, 128 (CCPA 1977) (reference disclosed property argued to be unexpected); *In re Skoll*, 523 F.2d 1392, 1397, 187 USPQ 481, 484 (CCPA 1975) (reference suggested the desirability of substituting reagent for that used in the process of another reference); *In re Gershon*, 372 F.2d 535, 537-39, 152 USPQ 602, 604-05 (CCPA 1967) (references teach the superiority of using a reagent for a particular purpose); *In re Dunn*, 349 F.2d 433, 439, 146 USPQ 479, 483 (CCPA 1965) ("[W]e do

not feel it an unreasonable burden on appellants to require comparative examples relied on for non-obviousness to be truly comparative.”).

Accordingly, based on our consideration of the totality of the record before us, we have weighed the evidence of obviousness found in the combined teachings of Stahl and Silver and as further combined with Bingham with appellants’ countervailing evidence of and argument for nonobviousness and conclude that the claimed invention encompassed by appealed claims 19 through 30 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner’s decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (2005).

AFFIRMED



CHARLES F. WARREN
Administrative Patent Judge

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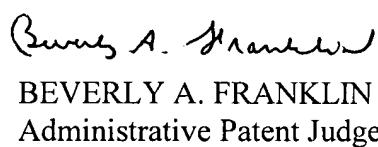
THOMAS A. WALTZ
Administrative Patent Judge

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Application 09/885,395

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